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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,395	04/01/2004	Marcus Braun	04265398	7589

7590 10/03/2006
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EXAMINER

TOY, ALEX B

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/815,395	Applicant(s) BRAUN, MARCUS	
	Examiner Alex B. Toy	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-13 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8/18/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 5, and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4 and 6 recite "preferably". This language renders the claims indefinite because it is not clear whether the claims are positively limited by the language that follows "preferably". Therefore, the metes and bounds of the claims are not clearly set forth as required.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 7-10, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Crainich (U.S. Pat. No. 5,549,637).

Regarding claim 1, Crainich discloses a surgical instrument comprising an instrument handle 12 linked to a proximal end portion of a tube shaft 14 (Fig. 1), the

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tube shaft having a distal end portion linked to an instrument head 20a (Fig. 1), so as to allow the instrument head 20a to bend (arrow P) relative to the tube shaft 14 (Fig. 1), the instrument head further comprising a rotatably (arrow T) supported effector 16, 92 (Figs. 1 and 6) having at least one pivotable engaging element (inherently pivotable forceps disclosed at col. 8, ln. 42-47), the instrument handle having a plurality of manipulators and/or operating mechanisms 66, 38, 90, 96 for operating the instrument head and/or the effector (Fig. 1), wherein a first manipulator 66 further comprises an operating element having the shape of a rotary knob and being rotatably supported on the instrument handle (col. 6, ln. 34-58 and Figs. 1, 6, and 7).

Regarding claim 4, Crainich discloses the surgical instrument according to claim 1, wherein the first manipulator 66 in the shape of a rotary knob is rotatably arranged at a distal end portion of a handle member of the instrument handle 12 and is preferably inclined with respect to the longitudinal axis of the instrument handle (Fig. 1). If the long axis of the non-moving grip of handle 12 is taken as the longitudinal axis, then the first manipulator 66 is inherently inclined with respect to the longitudinal axis of the instrument handle.

In addition, since the claim only recites "preferably", the last limitation is not deemed to be positively recited. Therefore, it is not necessary to meet that limitation.

Regarding claim 7, Crainich discloses the surgical instrument according to claim 1, wherein the first manipulator 66 forms the distal tip of the instrument handle 12 (Fig. 1).

Regarding claim 8, Crainich discloses the surgical instrument according to claims 1 and 7, wherein the first manipulator 66 is adapted to be operated by the fingers of a human hand (inherent, see Fig. 1).

Regarding claim 9, Crainich discloses the surgical instrument according to claim 1, wherein the first manipulator 66 is operatively connected, via a gear train 76, 56, 58, to the effector 16, 92 (col. 5, ln. 39 – col. 6, ln. 58 and Figs. 1, 6, and 7).

Regarding claim 10, see the references in the preceding rejection of claim 9.

Regarding claim 13, Crainich discloses the surgical instrument according to claim 1, wherein the instrument handle 12 has an ergonomically shaped handle member on which the manipulators and/or operating mechanisms 66, 38, 90, 96 of the instrument handle are supported (Fig. 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crainich ('637) in view of Freitas (U.S. Pat. No. 5,472,451).

Regarding claim 2, Crainich discloses the surgical instrument of claim 1, wherein the instrument handle 12 forms an operating mechanism 18, 34a-b, 38 for bending the instrument head with respect to the tube shaft 14 (col. 3, ln. 34 – col. 4, ln. 28 and Figs. 1, 4, and 5). The claim differs from Crainich in calling for the instrument handle to be pivotably linked to the tube shaft at the proximal end portion. Freitas, however, teaches a surgical instrument, wherein an instrument handle 18 is pivotably linked 29 to a tube shaft 11 at a proximal end portion in order to provide an adjustable orientation to facilitate surgery (col. 1, ln. 13-45 and Figs. 6-9). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the instrument handle of Crainich pivotably linked to the tube shaft at the proximal end portion in view of the teaching of Freitas in order to provide an adjustable orientation to facilitate surgery.

Regarding claim 6, see the preceding rejection of claim 4.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crainich ('637) in view of Rose (U.S. Pat. No. 5,147,357).

Regarding claim 11, Crainich discloses the surgical instrument of claim 1, wherein a lever-shaped manipulator 96 is arranged at a longitudinal side of the instrument handle 12 and is pivotable relative to the instrument handle and operatively

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connected to the effector 16, 92 (col. 7, ln. 36-50 and Fig. 1). The claim differs from Crainich in calling for the lever-shaped manipulator to be operatively connected via a gear train to the effector. As shown in Fig. 1, Crainich discloses using lever 96 to actuate push rod 94. Crainich further discloses that this push rod can be used to actuate forceps (col. 8, ln. 42-47). Rose then teaches using a lever-shaped manipulator with a push rod to actuate a gear train to open and close forceps jaws (col. 4, ln. 17-42 and Figs. 1-6). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the lever-shaped manipulator of Crainich operatively connected via a gear train to the effector in view of the teaching of Rose as an obvious way of using a lever actuated push rod to open and close forceps jaws that is known in the art.

Regarding claim 11, see the preceding rejection of claim 10.

Allowable Subject Matter

Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 5 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US 5174300 A	USPAT	Bales; Thomas O. et al.
US 5275608 A	USPAT	Forman; Jeffrey L. et al.
US 5318589 A	USPAT	Lichtman; Philip R.
US 5330502 A	USPAT	Hassler; William L. et al.
US 5350391 A	USPAT	Iacovelli; Benedetto
US 5374277 A	USPAT	Hassler; William L.
US 5474571 A	USPAT	Lang; Dieter
US 5545148 A	USPAT	Wurster; Helmut
US 5582617 A	USPAT	Klieman; Charles H. et al.
US 5603723 A	USPAT	Aranyi; Ernie et al.
US 5607450 A	USPAT	Zvenyatsky; Boris et al.
US 5609601 A	USPAT	Kolesa; Michael S. et al.
US 5643294 A	USPAT	Tovey; H. Jonathan et al.
US 5702408 A	USPAT	Wales; Kenneth S. et al.
US 5743456 A	USPAT	Jones; Christopher Scott et al.
US 5797958 A	USPAT	Yoon; InBae
US 5827323 A	USPAT	Klieman; Charles H. et al.
US 5997565 A	USPAT	Inoue; Masahide
US 6068647 A	USPAT	Witt; David A. et al.
US 20020055758 A1	US-PGPUB	Sasaki; Katsumi
US 6666854 B1	USPAT	Lange; Gregoire
US 6889116 B2	USPAT	Jinno; Makoto
US 6936061 B2	USPAT	Sasaki; Katsumi

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex B. Toy whose telephone number is (571) 272-1953. The examiner can normally be reached on Monday through Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AT *AT*
9/26/06

Michael Peffley
MICHAEL PEFFLEY
PRIMARY EXAMINER